



Please type a plus sign (+) inside this box



PTO/SB/21 (6-99)

Approved for use through 09/30/2000. OMB 0651-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/866,538
		Filing Date	MAY 24, 2001
		First Named Inventor	ROGER Y. TSIEH
		Group/Art Unit	1653
		Examiner Name	KAM, CHIH MIN
Total Number of Pages in This Submission	5	Attorney Docket Number	39754-0831 CP2

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> FEE TRANSMITTAL FORM <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> AFTER FINAL <input type="checkbox"/> Version With Markings Showing Changes <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 <input type="checkbox"/> Copy of Notice	<input type="checkbox"/> Copy of an Assignment <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> PETITION TO CORRECT PATENT TERM ADJUSTMENT HISTORY UNDER 37 C.F.R. §1.705(b) <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, by Assignee to Exclusion of Inventor Under 37 C.F.R. §3.71 With Revocation of Prior Powers <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Additional Enclosure(s) (please identify below): <input checked="" type="checkbox"/> STAMPED RETURN POSTCARD
Remarks		
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT 08-1641 FOR ANY FEES DUE IN CONNECTION WITH THIS PAPER, REFERENCING ATTORNEY'S DOCKET NO. 39754-0831 CP2		

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT			
Firm or Individual name	HELLER EHRMAN WHITE & McAULIFFE LLP	JAMES A. FOX (Reg. No. 38,455)	
	275 Middlefield Road, Menlo Park, California 94025	Telephone: (650) 324-7000	Facsimile: (650) 324-0638
Signature			
Date	JULY 2, 2004	Customer Number:	25213

CERTIFICATE OF EXPRESS MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated below and addressed to: MAIL STOP PETITION , Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450, on this date: JULY 2, 2004			
Express Mail Label EL 977 678 570 US			
Typed or printed name	C. FONG		
Signature		Date	JULY 2, 2004

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.



FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 200.00

Complete if Known

Application Number	09/866,538
Filing Date	MAY 24, 2004
First Named Inventor	Roger Y. Tsien
Examiner Name	Kam, Chih Min
Art Unit	1653
Attorney Docket No.	39754-0831 CP2

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit
Account
Number
Deposit
Account
Name

08-1641 (39754-0831 CP2)

HELLER EHRMAN WHITE & McAULIFFE LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	=
Multiple Dependent	-3** =	X	=

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) Petition to Correct Patent Term Adjust 200.00

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 200.00

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)	JAMES A. FOX	Registration No. (Attorney/Agent)	38,455	Telephone	(650) 324-7000
Signature		Date	JULY 2, 2004		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



7-06-04

~~DOAE~~
IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: Kam, Chih Min
Roger Y. TSIEN, et al.) Art Unit: 1653
Application Serial No. 09/866,538) Confirmation No. 4548
Filed: May 24, 2001) Attorney's Docket No. 39754-0831 CP2
For: NON-OLIGOMERIZING TANDEM) Customer No. 25213
FLUORESCENT PROTEINS)

EXPRESS MAIL LABEL NO. EL 977 678 570 US
Date Mailed: JULY 2, 2004

PETITION TO CORRECT PATENT TERM ADJUSTMENT HISTORY UNDER 37 C.F.R. § 1.705(b)

MAIL STOP: PETITIONS (c/o OPLA)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request reconsideration of the Patent Term Adjustment (PTA) accorded to the above-referenced application. In the Notice of Allowance, the *Determination of Patent Term Adjustment under 35 U.S.C. 154(b)* states that the PTA is "19" days. Applicants hereby request reconsideration of the PTA calculation and authorize payment of any necessary fees, including the fee in the amount of \$200.00 as set forth in 37 C.F.R. § 1.18(e) for the PTA adjustment requested, from Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39754-0831 CP2).

REMARKS

According to the U.S. Patent and Trademark Office (PTO), the total PTA for the above-referenced application based on the Applicants' Delay and PTO Delay is **19** days. Applicants respectfully submit that, as described in detail below, the correct total PTA for this patent is **21** days. Applicants are also in disagreement with the Applicants' Delay of **49** days, as indicated in the PAIR/PALM system. Applicants believe that the Applicants' Delay should be **47** days. A

review of the Patent Term Adjustment (PTA) in the PAIR/PALM system shows that the U.S. Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

A *Notice to File Missing Parts* was mailed July 25, 2001 with a two month response time. Applicants mailed a response and fees, via first class mail, on September 25, 2001. The PTO-return stamped postcard shows a receipt date of September 28, 2001. Therefore, Applicants believe that the Applicants' delay clock started on September 25, 2001 and should have stopped with the receipt of the response and fees on September 28, 2001, incurring an Applicants' delay of 3 days. Applicants are in disagreement with the PAIR/PALM system calculations according to which the Applicants' delay starts on July 25, 2001 and stops with the entry in the PAIR/PALM system of *Application is Now Complete* on October 30, 2001, incurring an Applicants' delay of 5 days. Applicants believe that the PAIR/PALM system is not calculating the actual date the PTO received the response to the *Notice to File Missing Parts* needed to stop the Applicants' clock.

A *Non-Final Office Action* was mailed on September 30, 2002 regarding the requirement for Election/Restriction of claims 1-87. Under 35 U.S.C. 154(b)(1)(A)(i)(I), the PTO was to issue the first *Non-Final Office Action* by July 24, 2002. Thus, the PTO delay of 68 days, as reflected in the PAIR/PALM system is correct and Applicants are in agreement with this calculation. Applicants filed a response to the *Office Action* by priority mail on October 30, 2002. The PTO received the response on November 4, 2002. Applicants filed a Preliminary Amendment by priority mail on December 13, 2002. The PTO received the Preliminary Amendment on December 17, 2002. Applicants believe that the Applicants' delay clock started November 4, 2002 and stopped December 17, 2002. Thus, the Applicants' delay of 43 days, as reflected in the PAIR/PALM system is correct and Applicants are in agreement with this calculation. A *Final Office Action* was mailed December 9, 2003. Applicants mailed a response, via Express Mail, on January 30, 2004. Applicants mailed a supplemental response to the December 9, 2003 *Final Office Action*, via Express Mail, on March 10, 2004. Applicants believe that the Applicants' delay clock started March 9, 2004 and stopped with the supplemental response received by the PTO on March 10, 2004. Thus, the Applicants' delay of

1 day, as reflected in the PAIR/PALM system is correct and Applicants are in agreement with this calculation.

Therefore, Applicants respectfully submit that this application is entitled to a total PTA of **21** days (the PTO Delay of 68 days minus the Applicants' Delay of 47 days) and request adjustment accordingly.

Additionally, Applicants do not believe the \$200.00 charge for reconsideration of the PTA should be charged to the Applicants, as the error was made on the part of the PTO. However, the United States Patent and Trademark Office is authorized to charge any additional fees, and to credit any overpayments or refunds, that may be due in connection with this application, to Deposit Account No. **08-1641** (referencing Attorney's Docket No. **39754-0831 CP2**).

Should there be any questions, please contact the undersigned at the correspondence address listed below. Thank you for your consideration.

Respectfully submitted,

Dated: July 2, 2004

By:



James A. Fox (Reg. No. 38,455)

HELLER EHRMAN WHITE & McAULIFFE LLP

275 Middlefield Road
Menlo Park, CA 94025-3506
Telephone: (650) 324-7000
Facsimile: (650) 324-0638
e-mail: jfox@hewm.com

SV 2045218 v1
7/2/04 10:11 AM (39754.0831)